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EXAMINER

FIELDS, BENJAMIN S

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CINDY HADFIELD

Appeal 2009-006957
Application 10/647,849
Technology Center 3600

Decided: March 29, 2010

Before, ANTON W. FETTING, JOSEPH A. FISCHETTI and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-5. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

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The Examiner relies upon the following as evidence of unpatentability:

Lam 2003/0074315 Apr. 17, 2003

www.deluxe.com (hereinafter "Deluxe")

The Examiner rejected claims 1-5 are rejected under 35 U.S.C. § 103(a) as obvious over LAM United States Publication 2003/0074315 in view of Deluxe (www.deluxe.com).

Claim 1 the sole independent claim recites:

1. An Internet-based check ordering and reordering system, including:
a client computer system;
an Internet-based server having a check order entry user interface remote from and in operable communication with said client computer system, wherein said Internet based server includes software for enabling input at said interface of client data, client check number data, client bank transit number data including bank branch name, address and branch number, client bank account data, and client bank routing data at said check order user interface and has means for transmitting said bank client bank transit number data, said client bank account data, and said client bank routing data in an encrypted manner; a bank transit number computer system remote from and in operable communication with the Internet-based server computer system having software for receiving at least said client bank transit number data, said client bank account data, and said client bank routing data from said Internet-based server and de-encrypting said client bank transit number data, said client bank account data, and said client bank routing data, and comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to bank transit data in said database, and transmits to said Internet- based server verified check print data which includes said client bank transit number data, said client bank account data, and said client bank routing data and a predetermined printing orientation; and

a printing station in operable communication with said Internet-based server computer system to print checks bearing said data thereon and a blank amount field.

Appellant argues the following language in claim 1 is distinguishable over the prior art: *comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to bank transit data in said database.*

In support, the Appellant argues that:

“missing is the element of the instant invention which compares at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank transit number corresponds to bank transit data in the database (i.e., the database being federally provided). This information is required in the instant invention in order to perform a validation and goes to the heart of the instant invention. By so providing, there is not only a reduced chance of misinformation but also a mechanism in which to more securely and accurately speed the process of check ordering and reordering. Further, there is provided a mechanism by which to reduce printing costs through reduced printing error and increased competition local printers. Currently, local banks have established relationships with a printer and govern the cost of check book reorders through these relatively noncompetitive relationships.” (Appeal Br. 9)

As set forth above, Appellant maintains criticality in the above-italicized feature for the reasons so given. Thus, this feature is a core issue.

In response, the Examiner's finds that the above listed limitation is disclosed by Deluxe and/or that it is old and well known, stating: "See Deluxe Site Page (www.deluxe.com); See Links to Other Subsystem Elements On the Site Page; consider old and well known check order/reorder techniques within the financial market" (Claim chart at (Answer 14)).

However, the Deluxe Site Page does not disclose how links to other subsystem elements result in comparing at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to bank transit data in said database. Even assuming a verification process occurs with respect to the user in Deluxe (Answer 5), it is unclear as to what data the user account information is being compared, nor does it show how a person with ordinary skill in the art would conclude that client bank transit number data is compared with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system.

Nor will the official notice taken suffice as a showing of obviousness given that Appellant has argued the criticality of this feature. The Examiner cannot rely on Official Notice for core factual findings. *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001)(With respect to core factual findings in a determination of patentability, however, the Examiner cannot simply reach conclusions based on

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their own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.)

Since claims 4-5 depend from claim 1, and since we cannot sustain the rejection of claim 1, the rejection of claims 4-5 likewise cannot be sustained.

REVERSED

JRG

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